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United States  
Circuit Court of Appeals  
For the Ninth Circuit

SAMUEL EAGLE, JOHN WILLIAM  
LANGS, and PLOMB TOOL COM-  
PANY, a corporation,

Appellants,

vs.

P. & C. HAND FORGED TOOL COM-  
PANY, a corporation,

Appellee.

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Appellee's Brief

*Appeal from the United States District Court for the  
District of Oregon.*

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HONORABLE JAMES ALGER FEE, District Judge.

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Appellee's Brief

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APPELLEE'S BRIEF

The patent sued on, issued to plaintiff, Samuel Eagle, June 7th, 1921 (Trans. 33), concerns a so-called Flex-Handled Wrench; probably so-called because

the head or socket-holding member is pivoted to the handle, so that it may be arranged at different angles with the shank, as convenient for the work to be done.

An earlier and similar type of Flex-Handled wrench is shown by the patent to Edmands, Number 820,185, issued May 8, 1906, (See Defendant's Exhibit D, Trans. 53, and the model of this wrench, Defendant's Exhibit AA, Trans. 96).

Plaintiff's patent has but one claim. If this claim were valid defendant's wrench would infringe.

The Patent Office failed to find the Edmands Patent in its examination of the prior art; also failed to cite several other very pertinent references. Nevertheless, even the prior art cited by the Patent Office restricted Eagle's patent to the single narrow claim which he accepted. It was the contention of the defendant in the District Court, and that Court so found, (Trans. 17) that the prior art is a complete anticipation of the alleged patentable combination purported to be described by Eagle's Patent and that his patent is therefore void.

In the first place let us examine the File Wrapper of Eagle's patent application, and consider the prior art therein cited.

Eagle's patent application initially contained four claims, three of which were in substance alike—hence it



will suffice to consider claim 1 and claim 4, which is the most specific of such initial claims: (See File Wrapper, pp. ~~731-7~~ in Supplemental Transcript of Record.) 175

#### CLAIM 1.

In a wrench, a head and a handle (1) pivotally secured to the head (4) to allow of swinging movement in a verticle plane.

#### CLAIM 4.

In a wrench, a head (4) having one end squared and the other end (6) rounded, a shank (3) spanning the rounded end of the head and pivotally connected thereto by a pivot pin (5), a handle (1) permanently secured to the shank and a spring pressed catch (8, 9) carried by the shank and riding the rounded end of the head and engageable with an indent (7) provided in the head.

(The numerals inserted after the elements of these claims are those employed by Eagle in his patent specification to identify the parts.)

The examiner of the Patent Office in his first action dated December 9, 1920 (see File Wrapper, pp. ~~731-10~~) Trans, cited the patent to Miottel, No. 1,169,987, dated February 1, 1916, being defendant's Exhibit G (Trans. 71); Patent to Mandeville, No. 348,565, dated September 7, 1886, being defendant's Exhibit C (Trans. 49) and the patent to Helstrom, No. 1,168,204, dated January 11, 1916, being defendant's Exhibit F (Trans. 65) and rejected all of said initial claims stating:

“Claims 1, 2 and 3 are rejected as failing to patentably distinguish from either Miottel or Mandeville, above cited. The elements B of Mandeville and 3 of Miottel are considered the equivalent of applicant’s member 4.

Claim 4 is rejected on Miottel in view of Helstrom, above cited. No invention would be involved in placing Helstrom’s member 30 in the member 2 of Miottel. \* \* \*”

Eagle’s attorney, in response to said action canceled all the initial claims, and substituted two new claims numbered 1 and 2 (File Wrapper, pp. ~~731-11~~). 178

The first of these substituted claims read:

1. A wrench comprising a handle, (1) a socket support (4) pivotally secured thereto and a socket (10) open at both ends and adapted to slidably receive the socket support in one end thereof.

The second of such substituted claim it is convenient to consider in parallel relation with initial claim 4 of the Eagle application with each of such claims divided into its component elements, thus—

Initial claim 4 of Eagle application, rejected by Patent Office and cancelled.

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In a wrench  
a head (4) having one end squared and the other end rounded (6)

a shank spanning the rounded end of the head and pivotally connected thereto by a pivot pin (5)

a handle (1) permanently secured to the shank

and a spring pressed catch (8, 9) carried by the shank (3) and riding the rounded end of the head (4) and engageable with an indent provided in the head

Single claim of Eagle patent No. 1,380,643

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A wrench comprising a handle (1) having a bifurcated shank (3)

a socket-support (4) having one end mounted and pivotally secured (5) between the branches of the shank bifurcations and the other end squared

a nut engaging socket (10) having a squared bore adapted to slidably receive the squared end of the socket support (4) therein

*and means (8, 9) carried by the handle and engageable with the rounded end (6) of the socket support (4) to hold the latter in different positions*

(The numerals inserted after the elements of these claims are those employed by Eagle in his patent specification to identify the parts.)

In submitting this amendment and substituted claims Eagle's attorney said:

“The two new claims now presented for consideration are thought to be allowable, inasmuch as none of the references show a socket support in the form of a solid body having one end pivotally secured to the handle and the other end adapted to be slidably received in the bore of the nut engaging socket. With this construction applicant needs no fastening means for holding the socket support and the socket together depending merely upon the frictional engagement between the parts. The references also fail to disclose a socket support and socket assembled together and held against relative pivotal movement, the socket support being pivotally secured onto the handle and adapted to be held at various positions with respect thereto.”

In the further action of the Patent Office, dated January 13, 1921 (File Wrapper, <sup>Trans 180</sup> ~~page 13~~), the Examiner said:

“This case, as amended January 7, 1921, has been re-examined, and the following art is cited:

**BALTZLEY**, 1,209,658, December 26, 1916.

Claim 1 is rejected as failing to distinguish patentably from Baltzley. Patentee's member 12 constitutes a pivoted member equivalent to applicant's member 4. Member 10 is a socket open at both ends.

Claim 2 is allowable, as at present advised.”

The Eagle patent was thereupon issued with said substituted claim 2.

The new feature which distinguished this substituted claim from the prior art, as found by the Examiner, is the last italicized element of said claim.

But the Patent Office failed to cite all the pertinent prior patents as references, namely the said Edmands Patent (Trans. 53) which also shows “means carried by the handle and engageable with the rounded end of the member (b) to hold the latter in different positions”, for, as above mentioned, the Patent Office ruled that Eagle’s member 4 is considered the equivalent of elements B of Mandeville (patent) and 3 of Miottel (patent) to which ruling the Eagle’s attorney made no objection, and thus under the same ruling, *Edmands’ socket-member b is the full equivalent of Eagle’s socket-holding member 4.*

A further pertinent reference omitted by the Patent Office, was the Patent to Miller and Burg, No. 1,175,973, dated March 21, 1916 (Defendant’s Exhibit H, Trans. 75), which shows in parts 8, 13, and 15 means for holding a handle-section of a wrench movably engageable with another member of the wrench, in order to hold the latter in different positions; and further failed to cite the very pertinent patent to Fairchild, No. 1,292,285, dated January 21, 1919 (Defendant’s Exhibit J, Trans. 85; a model of which patent is Defendant’s Exhibit M, Trans. page 101), which patent shows a Socket Wrench provided with a pivoted male socket-holder 17 to which to attach a socket 42, for engaging a nut 43, as illustrated by Fig. 1 of the drawing of this

patent. The patent specification of this Fairchild patent states its object to be identical with that of the Eagle Patent, viz:

“It is the main and primary object of the present invention to improve the general construction of socket wrenches whereby to render them capable of greater range of use in restricted localities, and to simplify the same as far as possible in order to reduce wear in the working parts to a minimum, and thereby prolong the life of the wrench.”

Notwithstanding the very specific feature to which Eagle's patent claim is limited and the fact that this same feature is shown both in purpose and result by the Edmands Patent, plaintiff still contends that the Eagle Patent covers a patentable combination.

Let us now see on what this combination is based.

Plaintiff's witness, Pendleton, testified that the “special feature” of the Eagle wrench is that the part marked “4” in the patent is “pivoted to the handle (1)” and may be moved on its pivot laterally (Trans. 43).

By comparing the Eagle Patent (Trans. 33) with the prior Edmands Patent (Trans. 53) it will be seen that the handles of both wrenches terminate at one end in a fork, in which a piece is pivoted. Edmands' piece b is a socket adapted to receive the nut, while Eagle's piece 4 is a connecting element on which to affix the particular socket to be used. In purpose and mode of operation both wrenches are obviously the same.

As already stated, the Patent Office ruled that a socket like Edmands' piece b—a similar socket piece as B of Mandeville patent (Trans. 49) and socket piece 4 of Miottel patent (Trans. 71)—is the equivalent of Eagle's male connector 4.

Eagle was bound by his acceptance of such ruling of the Patent Office. *Broadway Towel Supply Co. v. Brown Meyer Co.*, 245 Fed. 659, 661.

Pendleton admitted "that it might be *a mechanical choice for convenience of operation*, to make the movable piece 4, which is the socket support of the Eagle wrench, either male or female; but to make such socket as a female connection would be a very impractical expedient." (Trans. 47.)

Mechanical choice or expediency, of course, means that the mechanic using a tool would adapt it so as to be best suited for the work to be done with it. Pendleton refers to such expedient as "impractical", because "to have a female end on this (Edmands') wrench would require *an adapter* or some other joint to again reduce the female end to a male end so that mechanics generally who are equipped with sockets of which there is a universal use would then have a male connector to put in" (Trans. 46).

The "*adapter*" to which Pendleton referred as necessary to be used with the Edmands wrench, in order to use it in the same manner as the Eagle wrench, is a de-

vice which was common to the art when Eagle entered the field with his alleged improvement. Adapters were provided so as to permit the use of different makes of sockets with different makes of wrench handles. The catalogue published by the plaintiff Plomb Tool Company shows on pages 18 and 28 (Defendant's Exhibit Q, Trans. 121), different types of adapters, which, as said catalogue states, the Plomb Tool Company furnishes "to enable Plomb sockets to be used with handles of other makes, or Plomb handles with other sockets." A standard socket, plaintiff's witness, Buhler, said is "a round" socket with a hole through both ends (Trans. 149). See the samples of sockets constituting part of defendant's Interrogatory Exhibits A and B (Trans. 120) and the photograph of such Exhibit shown in defendant's Exhibit R (Trans. 153).

On Page 18 of said catalogue of the Plomb Tool Company is shown (first cut from the left) a "double male adapter" (Trans. 121). The adapters shown on said Page 18, are, "identical" with those shown on Page 28 "with the addition of one part of different type \* \* \* the double male feature." Plomb Tool Company's "double male" adapter could be used in connection with Edmands' wrench. Such use was just what the Plomb Tool Company purposely provided for; and it is self-suggesting to any mechanic.

Buhler, one of plaintiff's expert witnesses criticised the Edmands Wrench because the socket piece b was made removable, so that it may be substituted by an-



other socket. Buhler's criticism about such construction was that the socket (b) might "drop off" when using the wrench in certain positions (Trans. 149); and Buhler further ventured to inform the Court that "just to take that piece off and replace that, and hinge permanently in place a male socket holder" was such a job as 'an ordinary mechanic' could not do if asked to do so." (Trans. 150.)

Shim, an expert mechanic, called by defendant (Trans. 107), being asked to express his opinion on any comparative advantage which he saw over the Edmands prior art, testified he could not find any advantage either in use or construction in the Eagle patent over the Edmands patent.

He was further asked:

"Q. Now just look at the Fairchild patent, defendant's Exhibit J, and the model of the same, defendant's Exhibit M. Now with the Fairchild patent before you and the Edmands patent before you, would you find, as a mechanic, any difficulty in providing in a wrench a socket support, a male socket support or square head, as they call it, as a means for holding that socket support in different angular positions with respect to the nut?

A. No trouble whatsoever.

Q. What would you think of a mechanic who found difficulty in making such a wrench?

A. I wouldn't call him a mechanic."

Plaintiff seemed to be averse to going into further details about the differences in construction and result between the earlier Edmands' patent and plaintiff's patent. When the defendant endeavored to inquire into this matter the plaintiff objected (Trans. 47 and 140).

Pendleton, finally summing up all the advantages which the Eagle wrench had over Edmands' wrench and other devices in the prior art, said (Trans. 155):

“Q. What, in your opinion, is the main advantage of the Eagle wrench over the references cited by the defendant as prior art? Can you say that in a few words, what advantages?”

A. The chief advantages are twofold. One is that the Eagle wrench is a one-handed wrench, and second, that the Eagle wrench is designed to be used with the usual standard sockets in possession of the trade.”

The “one-handed feature” referred to by the witness is the pivoting of the male connector 4 of the Eagle wrench permanently in the bifurcated end 3 of the handle (see Eagle Patent, Trans. 33). Such feature is, however, illustrated by the prior socket wrench described by the Fairchild patent, defendant's Exhibit J, overlooked by the Patent Office (Trans. 85; and see defendant's Exhibit M, a model of this patent, Trans. Page 101).

Fairchild shows in Fig. 1 of his patent drawing a pivoted male socket holder 17 to which to attach a

socket 42 for engaging a nut 43. The patent specification of Fairchild (page 1, line 15) states its object to be identical with that of the Eagle patent.

The providing of a wrench adapted for the use of standard sockets was an old idea as apparent from, and taught by the advertisement in the Plomb Tool Company's own catalogue as above mentioned.

That Eagle was charged with knowledge of the prior art is an elementary rule in patent law, *Mast Co. v. Stover Manufacturing Co.*, 177 U. S. 485, 493.

The narrow, illogical ground on which plaintiffs finally would sustain the Eagle patent is brought out by plaintiffs' comparison of defendant's two Interrogatory Exhibits "A" and "B", duly introduced in evidence (Trans. 120).

In connection with these exhibits defendant's counsel put the following question to the plaintiffs:

"Before defendant rests, I desire to have plaintiffs advise defendant as to plaintiffs' position on the question of infringement. Referring to defendant's Interrogatory Exhibit 'A', this is made with a male plug to receive a socket on it. Defendant's Interrogatory Exhibit 'B' is made with a female wrench receiving part. The only difference between the two exhibits is the substitution of a female wrench-engaging part for a male wrench-engaging part. I call attention to the ruling of the Patent Office which occurs on page 10

of the file-wrapper, defendant's Exhibit 'L', Paper No. 2 (See Supple. Trans.). The Examiner stated that the element B of the Mandeville patent, defendant's Exhibit 'C', and the element 3 of the Miottel patent, defendant's Exhibit 'G', are considered the equivalent of member 4 of the Eagle wrench. I want to know whether the failure by plaintiffs to introduce a wrench of the type of defendant's Interrogatory Exhibit 'B' was because no infringement is claimed on that type of wrench.

“MR. RAMSEY: It is plaintiffs' contention that the handle and the female head shown in defendant's Interrogatory Exhibit 'B' is not the equivalent, and is not claimed to be an infringement of the Eagle patent. However, when that has been modified by a coupler or adapter so that the wrench has a male head and can be used in combination with a common socket, then it approaches the plaintiffs' patent; and if this Court holds that this patent is entitled to broad interpretation, *plaintiffs claim that defendant's Interrogatory Exhibit 'B' when used with an adapter infringes the Eagle patent.* If, however, the Court considers the Eagle patent to have a narrow interpretation, we wish the Eagle patent to be so limited.”

Defendant introduced as defendant's Exhibit “P” an “Adapter” which can be used with defendant's Interrogatory Exhibit “B”. (Trans. 123.)

Plaintiffs would thus reopen for review the finding of the Patent Office that a socket or female nut-engag-

ing element, such as shown by Edmands patent, is equivalent of Eagle's male nut-engaging element. Such discussion being closed, plaintiffs' contention is, in effect, an admission that the Edmands patent shows a complete anticipation of Eagle's patent claim.

For, that which infringes if later than the patent anticipates if earlier. *Knapp v. Morss*, 150 U. S. 221, 228.

Much ado was made about the fact that while the Edmands patent was issued in 1906, this type of Flex-Handled wrench did not go into *extensive use* until the Eagle wrench was put on the market. But this is readily explained. The Flex-Handled wrench is essentially an auto-mechanics' wrench and it grew with the auto industry. (Trans. 37.)

As Carlborg, plaintiff's witness said "There were places on the motors and chassis of the car that required a wrench of special design, because there were places hard to get at." (Trans. 137.)

And besides, *the Plomb Tool Company spent "between \$10,000.00 and \$12,000.00 in exploiting" the Eagle wrench.* (Trans. 44.)

Judge Fee in his opinion (Trans. 161) in considering "what novelty the Patent Office believed the (allowed) claim covered" said:

“\* \* \* Probably the feature of permitting the socket head to be held in different positions is the differentiating factor. At all events it seems perfectly clear that if the (patent) office had discovered the Edmands Patent (1906) for a like wrench, the patent in suit would not have issued. \* \* \* \* Hoe Company v. Goss Press Co., 30 Fed. (2d) 271, 274. \* \* \* The Edmands Patent has the same features except that the socket support and the socket itself are in one piece and are adapted to be removed from the pivot pin when the eye is opposite to one edge of the lug.

“It is perfectly obvious that when the wrench is being used to remove a nut the functions performed by each member are the same, and the parts are functionally equivalent. The same operation is performed by each in the same way and by the same means. The socket engages and holds the nut for the turning operation, the socket support actuated by the handle turns the socket, the handle is the means by which the twisting force is applied, through the bifurcated shank, and the latter prevents relatively pivotal movement. Likewise the means carried by the handle and engageable with the socket support hold the latter in different positions.

“It may be objected that the socket and socket support are mounted together, but that cannot affect the fact that for its useful purpose the functional effect is the same. The relation of the parts to one another is the same functionally in each tool.

“On the other hand the methods of attachment if new in the art might themselves constitute invention. It is clear enough that the eye placed upon the lug to make it removable by Edmands, was not essential to holding the socket head in various posi-

tions, and could have readily been dispensed with if it had been desired only to perform that function. Furthermore, any mechanic instructed to make the head irremovable would have simply closed the gap and the function for the device for holding the head in various positions would have been as efficient as that upon the Eagle patent. No novelty can be found in this feature.

“Considering the squared end for mounting the now standard sockets, it has been noted that the Patent Office holds interchangeable as an old device a squared male and a recessed female member. In the Fairchild Patent (1919) which was not cited, there appears as accessory to a ratchet wrench, a male plug or head slidably mounted in a socket. The same result can be obtained with an adapter, which is a device old in the art and permits a change of female member into a male part. Therefore patentability cannot be claimed for this feature. Citing authorities. \* \* \*

“When one looks at the Edmands Patent and considers the extensive use to which the standard sockets had been placed before plaintiff’s patent was applied for, it is inconceivable that anyone, whether mechanical or not, if informed of the need of adapting the patented device to the use of the standard socket, could not have evolved the Eagle patent.

“It is insisted that because of the extended use which the device manufactured by the Plomb Tool Company has received, this court is bound to find invention therein. But where the element of invention is lacking, widespread use will not prevail to support a patent. *Adams vs. Bellaire Stamping Co.*, 141 U. S. 539, 542. ‘The fact that the patented device has gone into general use, while evidence of

its utility, is not conclusive of its patentable novelty.  
 \* \* \* A patent must combine utility, novelty and invention. It may embrace utility and novelty in high degree and still be only the result of mechanical skill as distinguished from invention.’ Klein vs. City of Seattle, 77 Fed. 200, 204.

“The patent laws are for the purpose of fostering invention, and when that element is found it is right and proper that the fruits thereof be protected. But it would be unfair and unjust to permit one by a clever combination of devices old in the art and which already belong to the public, to monopolize a field and take from the people at large what already belongs to them.

“The patent in suit is declared invalid.”

## ARGUMENT AND AUTHORITIES.

The opinion of the District Court, the result of painstaking consideration of plaintiffs’-appellants’ contentions, covers fully the facts and the law of this case as evident.

As pointed out in Judge Fee’s opinion, Edmands’ Patent shows a “Flex-handled” wrench, and the “means carried by the handle and engageable with the rounded end of the socket support to hold the latter in different positions”—the only feature in Eagle’s wrench which the Examiner of the Patent office found as distinguishable from the prior art which he cited—is unquestionably found in the Edmands patent, while the providing of a male-connector on which to fasten a socket is



unquestionably found in the Fairchild Patent (Trans. 85). Fairchild's patent specification states, Page 2, line 89—

“The herein described wrench is designed for use with an assortment of sockets one of which is illustrated in Fig. 1 and designated by the numeral 42”; and on the same page, at line 114 states—

“By the construction described the shank 10 may stand in relation to the engaging head as in Fig. 1, in which position it is in alinement therewith, or it may be swung at right angles thereto, or it may be moved in any position intermediate of the two described, as illustrated in Fig. 3.”

A construction mechanic with the Edmands and Fairchild patents before him, as the law presumes (Mast v. Stover Manufacturing Co., 177 U. S. 485, 493) certainly would have no difficulty in modifying the Edmands wrench by substituting a male socket-connector in place of his socket, a mere “*mechanical choice for convenience of operation*” as plaintiffs' own expert witness, Pendleton, admitted. (Trans. 47.)

In Knapp v. Morss, 150 U. S. 221, 228, the Court said—

\* \* \* “The validity of the patent in question must be ascertained, not from a consideration of the purposes sought to be accomplished, but of the *means pointed out* for the attainment thereof, and if such means, adapted to effect the desired results, do not involve invention,

they can derive no aid or support from the end which was sought to be secured. All that Hall did was to adapt the application of old devices to a new use, and this involved hardly more than mechanical skill. \* \* \* “The same device employed by him (the patentee) existed in earlier patents; all that he did was to adapt them to the special purpose to which he contemplated their application, by making modifications which did not require invention, but only the exercise of ordinary mechanical skill; and his right to a patent must rest upon the novelty of the means he contrived to carry his idea into practical application’.”

It is elementary that it is immaterial in a patentable combination that all the elements are old per se. Such elementary rule is recognized in Judge Fee’s opinion. But only such combination as produces *a new result attributable to the association of the parts*, and not a mere summation of the results individually contributed by the elements, *is patentable*.

“No one by bringing together several old devices without producing a new and useful result, the *joint* product of the elements of the combination and *something more than an aggregate of old results*, can acquire a right to prevent others from using the same devices either singly or in combination. \* \* \* ”

Grinnell Machine Company v. Johnson Company,  
247 U. S. 426, 432.

It is not necessary that all the elements of a claim be found in a single patent. Dilg v. Geo. Dorgfeld & Co., 189 Fed. 588, 590; CCA 2d; Keene v. New Idea

Spreader Co., 231 Fed. 701, 708; CCA 6th (Cited by Judge Fee).

“The union of selected elements from various sources in a patented structure may be an improvement upon anything the art contains, but if, in combining them, no novel idea is developed, there is no patentable invention, however great the improvement may be.”

Turner v. Lauter Piano Co., 248 Fed. 930, 938; CCA 3d.

“There is no invention in merely selecting and assembling \* \* \* the most desirable parts of different mechanisms in the same art where each operates in the same way in the new device as it would in the old and effects the same results.”

Elite Mfg. Co. v. Ashland Mfg. Company, 235 Fed. 893, 895; CCA 6th Cir.

Two of the most pertinent patents, Edmands (Trans. 53) and Fairchild (Trans. 85, reproduced in Defendant's Model Exhibits AA and N) as pointed out in Judge Fee's opinion (Trans. 161, 163) show the alleged novel features of Eagle's wrench.

Eagle was charged with knowledge of these patents regardless whether he had actual knowledge of them or not, as Judge Fee said, citing Mast Co. v. Stover Mfg. Co., 177 U. S. 485, 493.

“Authorities concur that *the substantial equivalent of a thing*, in the sense of the patent law, is the same as the thing itself; so that if two devices do the same work in substantially the same way, and accomplish substan-

tially the same result, they are the same, even though they differ in name, form, or shape.”

Machine Company v. Murphy, 97 U. S. 120, 125, last paragraph.

“Invention can not be satisfactorily defined, \* \* \* but *Courts, adopting fixed principles as a guide, have by a process of exclusion determined that certain variations in old devices do not involve invention.*”

McClain v. Ortmyer, 141 U. S. 419, 427.

The basic principle in patent law is that the mere exercise of mechanical skill is not invention.

“It is well settled that not every improvement in an article is patentable. The test is that the improvement must be the product of an original conception (citations). *A mere carrying forward or more extended application of an original idea—a mere improvement in degree—is not invention.* (Citing Smith v. Nichols, 21 Wall. (U. S.) 112, 118, 119.) *Neither is it invention to combine old devices into a new article without producing any new mode of operation \* \* \* . It is not enough that a thing shall be new in the sense that the shape or form in which it is produced shall not have been before known, and that it shall be useful, but it must \* \* \* amount to invention or discovery.*”

Burt v. Evory, 133 U. S. 349, 358.

Electric Cable Joint Co. v. Brooklyn Edison Co., Inc., (1934) 54 U. S. Supr. Ct. Advance Sheets No. 11, P. 586.

“The mental faculties employed in the inventive act are the creative, not the imitative faculties. \* \* \* *Industry in exploring the discoveries and acquiring the ideas of others; wise judgment in selection and combining them; \* \* \* none of these are creation, none of these enter into the inventive act.*”

1 Robinson on Patents, Section 78.

“In the contemplation of the patent law not only any way which has already been employed, but also any way so like some previous way that it must be presumed to be within the mental reach of any one skilled in the art or trade wherein it belongs, is not the subject of patent.”

Merwin on Patentability of Inventions, page 12.

“The process of development in manufacture creates a constant demand for new appliances, which the skill of the ordinary head workman and engineer is generally adequate to devise \* \* \* . *To grant a single party a monopoly of every slight advance made, except where the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in principle and injurious in consequence.*”

Atlantic Works v. Brady, 107 U. S. 192, 199.

“Old devices frequently require alteration or modification to apply them to uses for which they are not

originally designed or adapted, and when the Court is satisfied that the changes require only the exercise of the skilled mechanic, the presumption of patentability running with the allowance of the patent is overcome.”

Cordley v. Richardson Corp., 278 Fed. 683, 685 (D. C. N. Y.)

“A new and analogous use of an old thing is not invention even though it effects results not before contemplated.” E. I. Dupont v. Glidden, 1 Fed. Supp. 1007, 1011. Howe Machine Co. v. National Needle Co., 134 U. S. 388, 397; St. Germaine v. Brunswick, 135 U. S. 227, 230, cited by Judge Fee in his opinion, Trans. 163.

Since in the case at bar, the File Wrapper shows, the Patent Office did *not* go fully into the prior art, indeed, *overlooked very pertinent prior patents*, the presumption of the validity of the patent is to that extent overcome and destroyed.

Dennis v. G. N. Railway, 51 Fed. (2d) 796 (D. C. Wash.). Webster, D. J., citing several cases. Westinghouse Co. v. Toledo Co., 172 Fed. 371, 372 (CCA 6th).

Hoe Co. v. Goss Press Co., 30 Fed. (2d) 271, 274 (CCA 2d).

The burden thus rested upon plaintiffs, to establish the patentable novelty in Eagle's patent.

The plaintiffs instead of carrying this burden not only *failed to introduce such proof, but purposely, studiously, avoided entering upon the investigation of that subject*; even thwarted any attempt on the part of defendant to pursue such investigation. (See Trans. p. 47 and p. 140.)

The large number of wrenches sold by the Plomb Tool Company has no bearing on the validity of Eagle's patent. The \$10,000 to \$12,000 spent by the Plomb Tool Company no doubt had a potential effect in enhancing its sales.

When doubt exists on the question of invention, extensive purchase by the public may turn the scale, but as Judge Fee remarked, that principle has no application in the instant case, citing *Adams v. Bellaire Stamping Co.*, 141 U. S. 539, 542.

And the Court of Appeals of this Circuit said in *Klein v. The City of Seattle*, 77 Fed. 200, 204—

“The fact that the patented device has gone into general use while evidence of its utility is not conclusive of its patentable novelty. \* \* \* A patent must combine utility, novelty and invention. It may embrace utility and novelty in high degree, and still be only the result of mechanical skill as distinguished from invention.”

The case at bar is an instance of the misuse of our patent laws so vigorously condemned in the familiar

case of *Brady v. Atlantic Works*, 107 U. S. 192, 200, referred to by Judge Fee in his opinion, in which the Court said (page 200) :

“The design of the patent laws is to reward those who make some substantial discovery or invention, which adds to our knowledge and makes a step in advance in the useful arts. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to law suits and vexatious accountings for profits made in good faith.”

\* \* \* \* \*

The decree of the District Court was right and should be affirmed.

Respectfully submitted,

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